No. 15-1293

In the Supreme Court of the United States

MICHELLE K. LEE, DIRECTOR,
UNITED STATES PATENT AND TRADEMARK OFFICE,
Petitioner,

v.

SIMON SHIAO TAM,
Respondent.

On Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

BRIEF OF JUSTICE AND FREEDOM FUND AS *AMICUS CURIAE* IN SUPPORT OF RESPONDENT

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INTEREST OF *AMICUS CURIAE*[1]

Justice and Freedom Fund, as *amicus curiae*, respectfully submits that the decision of the Eighth Circuit should be reversed.

Justice and Freedom Fund is a California non-profit, tax-exempt corporation formed on September 24, 1998 to preserve and defend the constitutional liberties guaranteed to American citizens, through education, legal advocacy, and other means. JFF's founder is James L. Hirsen, professor of law at Trinity Law School and Biola University in Southern California and author of New York Times bestseller, *Tales from the Left Coast*, and *Hollywood Nation*. Mr. Hirsen is a frequent media commentator who has taught law school courses on constitutional law. Co-counsel Deborah J. Dewart is the author of *Death of a Christian Nation* (2010) and holds a degree in theology (M.A.R., Westminster Seminary, Escondido, CA). JFF has made numerous appearances in this Court as *amicus curiae*.

INTRODUCTION AND SUMMARY OF THE ARGUMENT

Section 2(a) of the Lanham Act has been called a "Hodgepodge. . .a statutory monster." Carl J. Minniti III, *Article: The Lanham Act's Unconstitutional*

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[1] The parties have consented to the filing of this brief. *Amicus curiae* certifies that no counsel for a party authored this brief in whole or in part and no person or entity, other than *amicus*, its members, or its counsel, has made a monetary contribution to its preparation or submission.

Hodgepodge, 17 Rutgers J. Law & Relig. 315 (Spring 2016).

> Lurching quietly and stalking with menace, the Hodgepodge picked off unsuspecting victims for decades. In broad daylight, the Hodgepodge snuck behind its victim placing a muzzle on their mouth. Anyone who gave a cross eye – ridiculed. Anyone who dares question the Hodgepodge's existence – a heretic. An amalgam of supposed morality and societal decency, the Government released the Hodgepodge on any citizen bold enough to wade into commercial waters without sensitivity to such morality and societal decency. For years, the Hodgepodge has been the Government's loyal hound, eager to deny federal protection to those stepping outside the bounds of accepted decorum. But, alas, the Hodgepodge may now be dead.

Id. This Court can assure that the "statutory monster" has a decent burial.

Section 2(a) is an anomaly, placed among statutory bars that actually serve the Lanham Act's purposes—avoiding confusing similarity and deception, protecting the markholder's investment. The "disparagement" provision is a classic content-based law. Even though that content is partially or wholly commercial, the government specifically targets its expressive aspects when refusing to register a "disparaging" mark. The highly subjective examination process leaves government officials free to manipulate the system and engage in viewpoint discrimination.

Petitioner's arguments consistently miss the mark. The government is neither speaking nor funding a message of its own. A trademark is created, owned and used by the markholder. A major purpose of trademark registration is to identify the source of goods—and that source is the markholder, not the government. Any message expressed by the mark is clearly identified with that markholder. The government is also not funding or subsidizing the markholders, their messages, or their commercial activities. On the contrary, user fees fund the registration program and the government appropriates no funds. The Lanham Act originated with congressional power under the Commerce Clause—not the Spending Clause. Registration grants legal rights to the markholder—not the government—and protects the markholder's investment—not the government's funds.

If this Court allows the government the ability to subjectively eliminate speech utilizing criteria that is unrelated to consumer protection, viewpoint-based discrimination of speech is the inevitable result.

The government performs administrative functions by maintaining a centralized database that is easily accessible to both consumers and businesses. It also acts in a regulatory capacity by ensuring that new registrations are not confusingly similar to previously registered marks. The government has distorted its role in a misguided attempt to transform private expression into a government subsidy and/or government speech. This case is an opportunity to clarify and cabin the government speech doctrine following *Walker v. Sons of Confederate Veterans, Inc.*, 135 S. Ct. 2239 (2015). This Court should limit that

doctrine to situations where the government disseminates its own message, and not allow it to encroach on private speech.

ARGUMENT

I. THE GOVERNMENT IS NOT DISSEMINATING ITS OWN SPEECH.

The government does not create, own, or control the use of a private trademark in the owner's business. The government does not own the goods which bear the mark and identify their source. The government has no financial investment in the mark. It is the private owner who creates the mark, applies for registration, retains ownership, and uses it in commerce. The government's role is administrative. As the Federal Circuit correctly concluded, "[t]here is no government speech at issue in the rejection of disparaging trademark registrations that would insulate § 2(a) of the Lanham Act, 15 U.S.C.S. § 1052(a), from First Amendment review." *In re Tam*, 808 F.3d 1321, 1345 (Fed. Cir. 2015).

The government's argument is "unmoored from the very concept of government speech." *Id.* at 1346. A trademark identifies the source of goods. That source is not the government but rather the markholder—and the "[u]se of a mark by its owner is clearly private speech." *Id.* at 1345.

The government never identifies a message it intends to disseminate through trademark registration. Trademarks convey a vast array of diverse messages. The government could not endorse every message without hopeless inconsistency, and Establishment Clause concerns would likely arise concerning marks

containing religious expression. There is no actual risk that the public would view a trademark registration as tantamount to government endorsement. *In re Old Glory Condom Corporation*, 26 U.S.P.Q.2d 1216, 1993 WL 114384 (T.T.A.B. 1993). On the contrary:

> Trademarks are understood in society to identify the source of the goods sold, and to the extent that they convey an expressive message, that message is associated with the private party that supplies the goods or services.

In re Tam, 808 F.3d at 1347. The government's association with trademarks is tangential, and its case citations bear little resemblance to the trademark registration scheme.

1. License plates are not analogous. The government's reliance on *Walker* is misplaced. License plates are perhaps "the quintessential example of speech that is both private and governmental." *Sons of Confederate Veterans, Inc. v. Comm'r of Va. Dep't of Motor Vehicles*, 305 F.3d 241, 245 (4th Cir. 2002). The state manufactures the plates, retains ownership, and places its name on them. The plates serve an important government function—vehicle identification. The private speakers' agreement with the message does not supersede the state's role. License plate schemes vary widely from state to state, or even within one state. Texas had three schemes, and only one of them was before this Court in *Walker*. *Walker*, 135 S. Ct. at 2244. Some, as in *Walker*, require a level of government editorial control that renders them government speech. *See also Berger v. ACLU*, 135 S. Ct. 2886 (2015), vacating and remanding *ACLU v. Tata*, 742 F.3d 563 (4th Cir. 2014) (North Carolina "Choose Life" and other

specialty license plates require legislative authorization). Individualized vanity plates—which were not before this Court in *Walker*—present stronger arguments for private speech. Trademarks, in contrast to license plates, are not owned by the state, use no state property, and bear no seal of government approval. The registration process is largely invisible to the general public, other than the small ® placed on a markholder's goods.

License plates are a unique avenue of communication, and while it is precarious to rely on them as precedent, a few notes of comparison are in order. There is a surface similarity between this case and *Walker*, where the government could refuse to create a specialty plate if, inter alia, "the design might be offensive to any member of the public." *Walker*, 135 S. Ct. at 2245; Tex. Transp. Code Ann. § 504.801(c). This is roughly parallel to the disparagement provision in trademark law. But the similarity ends there. The government's freedom to speak "reflects the fact that it is the democratic electoral process that first and foremost provides a check on government speech. See *Bd. of Regents of Univ. of Wis. System v. Southworth*, 529 U.S. 217, 235 (2000)." *Walker*, 135 S. Ct. at 2245. The Texas statutory scheme included a process that invited public comment. *Id.* This differs from trademark approval, where the government examiner has far broader discretion and a sole official may easily engage in viewpoint discrimination. Texas retained ownership of both the plate itself and the specialty design (*id.* at 2251)—unlike the trademark program where the markholder owns the design and the goods to which the mark is affixed. This Court found that Texas was "not simply managing government property,

but instead [was] engaging in expressive conduct." *Id.* Trademarks involve no comparable government expression. Instead, the government examines applications to ensure that a proposed mark is not confusingly similar to one already registered. This limited inspection serves the purposes of the Lanham Act. Finally, license plates have historically been used to promote state purposes rather than private expression. Opening the program to private expression also opened the door to litigation. *Walker* and other license plate cases highlight the difficulty, in some contexts, of drawing the line between public and private speech. But the line is not so blurred in trademark registration, where the only "government message" is the mere fact that a mark is registered.

The compelled speech doctrine in *Wooley v. Maynard* is even further removed from this case. There is no analogy whatsoever. *Wooley* addresses the "First Amendment right to avoid becoming the courier" for "the State's ideological message" by using one's personal vehicle as a "mobile billboard." *Wooley v. Maynard*, 430 U.S. 705, 715, 717 (1977). Here, there is no government message at all—let alone a message forced on private speakers.

2. Public monuments, libraries, and television stations are not analogous. *See Pleasant Grove City v. Summum*, 555 U.S. 460 (2009) (Ten Commandments monument donated for public park), *United States v. Am. Library Ass'n, Inc.*, 539 U.S. 194 (2003) (libraries), *Arkansas Ed. Television Comm'n v. Forbes*, 523 U.S. 666, 672-673 (1998) (public television). In these cases, the government retained editorial control over the

selections without endorsing the private message embedded in any particular item.

Moreover, the government speech argument is at odds with the purposes of the Lanham Act. The purpose of registration, by itself, is not expressive but administrative, although the markholder may create a particular mark for expressive purposes. Trademarks protect both consumers and markholders. The public can be confident of the source when buying a product that bears a particular trademark, and a markholder's investment is protected from misappropriation. *In re Tam*, 808 F.3d at 1328. The registry provides a convenient way for a business to avoid infringing a registered mark. Many of the bars to registration protect consumers—much like the regulation of commercial speech—from "misleading, deceptive, or aggressive sales practices." *44 Liquormart, Inc. v. Rhode Island*, 517 U.S. 484, 501 (1996). But the Lanham Act also grants substantial and exclusive rights that protect the markholder's investment, and that purpose is irreconcilable with classifying registered trademarks as government speech.

The trademark registry is a government database similar to real property titles, birth certificates, articles of incorporation, hunting and fishing licenses, parade permits, and copyright registrations. *In re Tam*, 808 F.3d at 1347-48. The government maintains records without granting an official seal of approval. The expression does not morph into government speech:

> To conclude otherwise would transform every act of government registration into one of government speech and thus allow rampant viewpoint discrimination. When the government

> registers a trademark, it regulates private speech. It does not speak for itself.

Id. at 1348.

II. THE GOVERNMENT IS NOT SUBSIDIZING SPEECH OR FUNDING ITS OWN MESSAGE.

The government has not funded trademark registration as part of a government spending program, but rather has constructed a legislative scheme that allows registered trademark users particular legal rights in court. Trademark registration is a regulatory regime administered by the government. It is not a government subsidy, either directly through a monetary grant or indirectly through a tax exemption. Congressional power to regulate trademarks used in interstate commerce is derived from the Commerce Clause—not the Spending Clause. *In re Tam*, 808 F.3d at 1353-54; *see Trade-Mark Cases*, 100 U.S. 82, 96 (1879). The government collects user fees from applicants to fund the registration program, and registration establishes important legal rights, but Congress has not appropriated funds to subsidize the use of trademarks. Furthermore, trademark registration does not inhibit the government's ability to use its own funds to subsidize particular activities. In this case, the question of funding is all about what the government is *not* doing, and the cases that are *not* analogous. Contrary to numerous suggestions from Petitioner (Pet. Op. Br. 8, 9, 10, 11, 14, 15, 19, 29, 36, 43, 44), the government is not engaged in funding or subsidizing the activities of trademark holders.

1. The government is not funding its own message, as it was in *Johanns v. Livestock Marketing Ass'n*, 544 U.S. 550 (2005). In *Johanns*, the government implemented a federal policy to promote the marketing and consumption of beef. That policy, established by statute (The Beef Promotion and Research Act of 1985), authorized raising funds through an assessment on cattle sales and importation. 7 U.S.C.S. § 2901(b). *Johanns*, 554 U.S. at 553. The government set the message and provided for the funding.

2. The government is not funding a message it favors. "The Government can, without violating the Constitution, selectively fund a program to encourage certain activities it believes to be in the public interest, without at the same time funding an alternative program which seeks to deal with the problem in another way." *Rust v. Sullivan*, 500 U.S. 173, 193 (1991). In *Rust*, the government funded family-planning services but chose to exclude abortion. *Id.* at 178. Similarly, a public television station can make editorial judgments about the material presented to viewers. *Forbes*, 523 U.S. at 672-673. The government may appropriate public funds for a program, and when it does, it may define the limits of the program. *Rust*, 500 U.S. 194. But the trademark registration program is not an appropriation of funds comparable to *Rust*. The government's reliance on this case is misplaced.

3. The government is not funding a competitive grant program, where it acts as a patron rather than a regulator. *National Endowment for the Arts v. Finley*, 524 U.S. 569 (1998). In an effort to support the arts, Congress established the NEA in 1965. Federal funds were pledged to "help create and sustain . . . a climate

encouraging freedom of thought, imagination, and inquiry." *Id.* at 573; 20 U.S.C.S. § 951(7). When the government allocates competitive funding in this manner, it may use "criteria that would be impermissible were direct regulation of speech or a criminal penalty at stake." *Finley*, 524 U.S. at 587-588. The refusal to award a grant is not censorship of the artist. The trademark registry is not a competitive grant program. But if it were, this Court noted that "even in the provision of subsidies, the Government may not aim at the suppression of dangerous ideas." *Id.* at 587 (internal citations and quotation marks omitted).

4. The government is not placing conditions on the use of federal funds. Congress may impose conditions on federal funding to achieve its policy objectives. *South Dakota v. Dole,* 483 U.S. 203, 206 (1987). *See, e.g., United States v. Am. Library Ass'n, Inc.,* 539 U.S. 194, 199 (2003) (public library receiving federal funds for internet access must install software to block obscenity or child pornography). Cases like these involve the Spending Clause, which is not the basis for congressional authority to regulate trademarks. Trademark owners do not receive any federal funds, but even where funding is involved, the government may not use conditions as leverage to limit constitutional rights outside the scope of the program it is funding. *Agency for Int'l Dev. v. Alliance for Open Soc'y Int'l, Inc.*, 133 S. Ct. 2321, 2326 (2013) (funds provided to nongovernmental organizations to fight HIV/AIDS could not be conditioned on the recipient maintaining a policy explicitly opposing prostitution and sex trafficking); *Legal Services Corporation v. Velazquez*, 531 U.S. 533, 547 (2001) ("Congress cannot

recast a condition on funding as a mere definition of its program in every case, lest the First Amendment be reduced to a simple semantic exercise.")

5. The government is not expending funds to encourage diverse expression—but trademarks display diverse private expression and the government is subject to similar constraints. *See, e.g., Rosenberger v. Rector and Visitors of Univ. of Va.*, 515 U.S. 819, 834 (1995) (viewpoint discrimination is impermissible "when the government does not itself speak or subsidize transmittal of a message it favors but instead expends funds to encourage a diversity of views from private speakers") (internal citations and quotation marks omitted); *Southworth,* 529 U.S. at 229 ("The University of Wisconsin exacts the fee at issue for the sole purpose of facilitating the free and open exchange of ideas.").

In short, this case does not involve government funding. Regardless of the content of a particular trademark—and even if it is "disparaging"—the government is not "underwrit[ing] the commercial use of racist, misogynist, or bigoted terms and imagery." *Walker*, 135 S. Ct. at 2245, 2252-2253.

III. THE GOVERNMENT TARGETS THE EXPRESSIVE ASPECTS OF SPEECH IN WHICH COMMERCIAL AND NON-COMMERCIAL EXPRESSION ARE "INEXTRICABLY INTERTWINED."

Trademarks are created by and identified with their private owners. Their use in commerce signifies commercial speech classification. This Court has referred to trademarks as commercial speech. *See, e.g.,*

Friedman v. Rogers, 440 U.S. 1, 11 (1979) (trade name of optometrist was commercial speech). But while many marks are purely commercial in nature, others incorporate political, social, and/or religious expression. Goods can be created and distributed to promote a message, and a trademark may be designed to identify the goods with that message. Under existing precedent the First Amendment "protects commercial speech from unwarranted governmental regulation." *Cent. Hudson Gas & Elec. Corp. v. Pub. Serv. Comm'n*, 447 U.S. 557, 561 (1980). And where that speech is intertwined with non-commercial expression, constitutional protection is even stronger.

When Congress exercised its Commerce Clause powers to pass the Lanham Act in 1946, courts had not yet recognized First Amendment protection for commercial speech. On the contrary, this Court had recently declared that "the Constitution imposes [no] restraint on government as respects purely commercial advertising." *Valentine v. Chrestensen,* 316 U.S. 52, 54 (1942). Kristian D. Stout, *Article: Terrifying Trademarks and a Scandalous Disregard for the First Amendment: Section 2(a)'s Unconstitutional Prohibition on Scandalous, Immoral, and Disparaging Trademarks*, 25 Alb. L.J. Sci. & Tech. 213, 222 (2015). Three decades later, "the notion of unprotected commercial speech all but passed from the scene." *Virginia Pharmacy Board v. Virginia Citizens Consumer Council, Inc.*, 425 U.S. 748, 759-760 (1976); *Bigelow v. Virginia*, 421 U.S. 809, 818 (1975) ("The fact that the particular advertisement in appellant's newspaper [for legal abortions in New York] had commercial aspects or reflected the advertiser's commercial interests did not negate all First

Amendment guarantees."); *Bolger v. Youngs Drug Prods. Corp.*, 463 U.S. 60 (1983) (First Amendment protects unsolicited mailings with information about contraception). The legal landscape shifted dramatically—but the Lanham Act remained intact. Some of its provisions track the rationale underlying commercial speech restrictions, but the "disparagement" bar erects an unconstitutional barrier to free expression.

A. The Disparagement Provision Does Not Serve The Purposes Of Trademark Law.

Trademark law and commercial speech regulation serve similar purposes. Commercial expression "not only serves the economic interest of the speaker, but also assists consumers and furthers the societal interest in the fullest possible dissemination of information." *Cent. Hudson*, 447 U.S. at 561. Regulation helps "to protect consumers from misleading, deceptive, or aggressive sales practices." *44 Liquormart*, 517 U.S. at 501. Similarly, Section 2(a) prohibits deceptive and confusingly similar trademarks, thus providing customers with information about the source of goods and services. Trademark registration also grants legal rights to protect the markholder's investment and assists potential registrants in avoiding duplication. The disparagement provision is not anchored to any of these purposes.

Moreover, commercial speech is sometimes "linked inextricably" with the underlying commercial transaction. The government's interest in regulating that transaction "may give it a concomitant interest in the expression itself." *Edenfield v. Fane*, 507 U.S. 761,

767 (1993) (CPA client solicitation). A trademark, similarly, might be linked to an activity subject to state regulation. But in denying registration to a "disparaging" mark, the government is not regulating the underlying commercial transaction. It is regulating —and suppressing—*only* the expressive aspects of the mark.

B. Trademarks May Contain "Inextricably Intertwined" Commercial And Non-Commercial Expression.

The First Amendment protects a wide range of expression. Its supremacy is evident across a wide spectrum of cases.[2] In addition to speech about political and other matters of public concern, it takes in the arts and entertainment—"serv[ing] a value similar to that fostered by the copyright laws—promoting the creation and dissemination of knowledge and cultural artifacts." Joseph P. Bauer, *ARTICLE: Copyright and the First Amendment: Comrades, Combatants, or Uneasy Allies?*, 67 Wash & Lee L. Rev. 831, 843 (Summer 2010). This Court places a premium on artistic expression, highlighting music as a key example:

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[2] *See, e.g., New York Times Co. v. Sullivan*, 376 U.S. 254, 292 (1964) (libel action against public official requires proof of "actual malice" in light of free speech rights); *Eastern Railroad Presidents Conference v. Noerr Motor Freight, Inc.*, 365 U.S. 127 (1961) (Sherman Act could not be applied so as to interfere with Petition Clause rights); *Bartnicki v. Vopper*, 532 U.S. 514, 535 (2001) (radio broadcast of intercepted phone conversation on a matter of public concern was protected by the First Amendment even though informants violated wire tap laws); *Marsh v. Alabama*, 326 U.S. 501, 509 (1946) (trespass law violated right of Jehovah's Witness member to distribute literature on a street in a company town).

> Music is one of the oldest forms of human expression. From Plato's discourse in the Republic to the totalitarian state in our own times, rulers have known its capacity to appeal to the intellect and to the emotions, and have censored musical compositions to serve the needs of the state. . . . The Constitution prohibits any like attempts in our own legal order. Music, as a form of expression and communication, is protected under the First Amendment.

Ward v. Rock Against Racism, 491 U.S. 781, 790 (1989). The mark in this case involves both political expression and music—both at the core of the First Amendment:

> With their lyrics, performances, and band name, Mr. Tam and his band weigh in on cultural and political discussions about race and society that are *within the heartland of speech protected by the First Amendment*.

In re Tam, 808 F.3d at 1331 (emphasis added).

Many commercial enterprises involve the creative expression of the business owner and/or customers—music, journalism, photography, graphic design, printing, floral arrangements, cake decorating. That expression may address current political issues or religious beliefs. When a trademark incorporates such non-commercial expression, government examiners are on thin First Amendment ice if they rule it "disparaging" and deny registration.

Assuming that trademarks are a form of commercial speech, where that speech is "inextricably intertwined"

with expressive speech, it does not retain its commercial character but instead must be treated as fully protected expressive speech. This Court "cannot parcel out the speech, applying one test to one phrase and another test to another phrase." *Riley v. National Federation of Blind, Inc.*, 487 U.S. 781, 796 (1988). That is particularly true when the expressive aspect is targeted for regulation. *Riley* built on a principle from an earlier case involving fundraising, where this Court recognized that "[s]olicitation is characteristically intertwined with informative and perhaps persuasive speech seeking support for particular causes or for particular views on economic, political, or social issues." *Village of Schaumberg v. Citizens for a Better Environment*, 444 U.S. 620 (1980). The same is true for trademarks. Trademarks identify commercial goods and services, but "that product or service is not of necessity a purely commercial object." *Terrifying Trademarks*, 25 Alb. L.J. Sci. & Tech. at 243.

Examples.[3] Some approved trademarks identify commercial goods but also transmit messages:

> By serving as a symbol to cultural and political movements, religions, or any other meaningful social structure, what may seem to be a mere commercial object is transformed into an expressive, meaningful cultural artifact.

Terrifying Trademarks, 25 Alb. L.J. Sci. & Tech. at 244. "I Love Boobies," a mark used for bracelets and sunglasses, was designed to raise breast cancer

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[3] *See Terrifying Trademarks*, 25 Alb. L.J. Sci. & Tech. at 244-247, for discussion of these examples.

awareness and found to be protected expression when a student wore a bracelet to school. *B.H. ex rel Hawk v. Easton Area Sch. Dist.*, 725 F.3d 293, 297-98 (3d Cir. 2013). "[T]he bracelet, a commercial good, became more than a mere commercial good by virtue of its reference to a larger social movement." *Terrifying Trademarks*, 25 Alb. L.J. Sci. & Tech. at 244. Examples from other circuits include: *Hoffman v. Capital Cities/ABC, Inc.*, 255 F.3d 1180, 1184 (9th Cir. 2001) (magazine about classic films was commercially available but contained non-commercial elements); *Ayres v. City of Chicago*, 125 F.3d 1010, 1017 (7th Cir. 1997) (t-shirts printed with social advocacy messages) ("There is no question that the T-shirts are a medium of expression prima facie protected by the free-speech clause of the First Amendment, and they do not lose their protection by being sold rather than given away.") When examiners apply Section 2(a) it is the expressive character of a mark, rather than the mark's suitability to serve as a source identifier, that ends up being the underlying basis for the disparagement exclusion from registration being applied.

C. The Disparagement Provision Cannot Survive Even The Intermediate *Central Hudson* Test For Commercial Speech.

The government has limited power to restrict commercial speech if "the communication is neither misleading nor related to unlawful activity." *Central Hudson Gas & Electric Corp. v. Public Service Commission*, 447 U.S. 557, 564 (1980). The limitation must directly advance a substantial state interest, and "if the governmental interest could be served as well by a more limited restriction on commercial speech, the

excessive restrictions cannot survive." *Id.* The framework developed by this Court is "substantially similar to the test for time, place, and manner restrictions." *Lorillard Tobacco Co. v. Reilly*, 533 U.S. 525, 554 (2001) (internal citations and quotation marks omitted). "But the abiding characteristic of valid time, place, and manner regulations is their content neutrality. See *Ward v. Rock Against Racism*, 491 U.S. 781, 791-796 (1989)." *Id.* at 573 (Thomas, J., concurring).

The disparagement provision of Section 2(a) is the antithesis of content neutrality—the government chills protected expression precisely because of its content. Accordingly, it cannot survive even the intermediate *Central Hudson* test—let alone the strict scrutiny that ought to apply. First, it is unrelated to misleading, deceptive, or unlawful communication. On the contrary, it "is squarely based on the expressive aspect of the speech, not its commercial-speech aspects" and thus "discriminates against the mark's political or social message." *In re Tam*, 808 F.3d at 1355. Second, the only government "interest" hinges on disapproval of the message, as perceived by a government official acting with broad discretion to render a value judgment. That judgment is likely speculative. The government must demonstrate that the restriction "directly advance[s] the state interest involved; the regulation may not be sustained if it provides only ineffective or remote support for the government's purpose." *Central Hudson*, 447 U.S. at 564. That burden "is not satisfied by mere speculation or conjecture." *Edenfield v. Fane*, 507 U.S. 761, 770-771 (1993). The government "must demonstrate that the

harms it recites are real and that its restriction will in fact alleviate them to a material degree." *Id.*

This Court should adhere to its earlier precedents by applying strict scrutiny to Section 2(a). Even if commercial speech has reduced constitutional protection, "the government may not engage in content discrimination for reasons unrelated to those characteristics of the speech that place it within the category." *Lorillard Tobacco*, 533 U.S. at 576 (Thomas, J., concurring). *See R.A.V. v. City of St. Paul*, 505 U.S. 377, 384 (1992) ("the government may proscribe libel; but it may not make the further content discrimination of proscribing *only* libel critical of the government"). The government may examine the content of a proposed mark to determine whether it is deceptive or confusingly similar to another mark—but not to suppress the ideas it expresses:

> The First Amendment requires heightened scrutiny whenever the government creates "a regulation of speech because of disagreement with the message it conveys." *Ward v. Rock Against Racism,* 491 U.S. 781, 791 (1989).

Sorrell v. IMS Health, Inc., 131 S. Ct. 2653, 2664 (2011) (striking down content- and speaker-based restrictions on the sale, disclosure, and use of prescriber-identifying information).

IV. THE GOVERNMENT IS CENSORING PRIVATE SPEECH—CONTRARY TO THE FIRST AMENDMENT.

The government has an administrative role in maintaining a centralized trademark database. Its limited examination of content ensures that a

registered mark accurately identifies the source of goods and is not deceptive, duplicative, or confusingly similar to another mark. This furthers the purposes of the Lanham Act. But additional examination—to determine whether a mark "disparages" some ill-defined group of persons or beliefs—thrusts the government into forbidden First Amendment territory:

> If there is any fixed star in our constitutional constellation, it is that no official, high or petty, can prescribe what shall be orthodox in politics, nationalism, religion, or other matters of opinion or force citizens to confess by word or act their faith therein.

West Virginia Bd. of Ed. v. Barnette, 319 U.S. 624, 642 (1943).

Although trademark registration is not a typical speech forum, it implicates similar concerns and constitutional principles. There is unacceptable subjectivity inherent in the government's discretion to find a mark "disparaging"—much like the impermissible "unbridled discretion" in a forum analysis. The result is an unconstitutional burden on protected speech that is tantamount to suppression.

A. Subjectivity Pervades The Examination Process.

The statutory text of Section 2(a) can be objectively construed using definitions in the Lanham Act. The relevant term—"persons"—is defined in 15 U.S.C.S. § 1127 to mean either a natural person or a "juristic" person such as a corporation, association, or other identifiable entity capable of suing or being sued. But the statute's objectivity vanishes under a cloud of

judicially crafted tests that presume "persons" may refer to some nebulous group such as Asian-Americans. "In no other area of federal jurisprudence would a court feel at liberty to determine whether political speech was accurate enough to warrant protection or federal recognition." *Terrifying Trademarks*, 25 Alb. L.J. Sci. & Tech. at 226 (commenting on *Lebanese*).

Earlier cases have found that "the greater objectivity of commercial speech justifies affording the State more freedom to distinguish false commercial advertisements from true ones." *44 Liquormart*, 517 U.S. at 499, citing *Virginia Bd. of Pharmacy*, 425 U.S. at 771, n. 24. In trademark law, there should be a similar objectivity in merely determining whether a proposed mark duplicates or is confusingly similar to an existing registered mark. But where examiners have broad discretion to find that a mark "disparages" a "substantial composite" of an identifiable (but vaguely defined) group, that objectivity evaporates. At the very least, examiners should return to the objective basis provided by the text.

Although the Lanham Act provides a clear definition of "persons," it fails to do the same for "disparaging"—leaving government examiners and courts to speculate. One court has defined a disparaging mark as one which "dishonors by comparison with what is inferior, slights, deprecates, degrades, or affects or injures by unjust comparison." *In re Geller*, 751 F.3d 1355, 1358 (Fed. Cir. 2014) (alterations omitted). In another case, the court crafted a two-part test, first determining the "likely meaning of the matter in question" and then "whether that meaning may be disparaging to a substantial composite

of the referenced group." *In re Lebanese Arak Corp.*, 94 U.S.P.Q.2d 1215, 1217 (T.T.A.B. 2010) (examining the religious and political meanings of the term "Islamisation"). "This – needless to say – is as subjective as you can get." *Hodgepodge*, 17 Rutgers J. Law & Relig. at 325.

Trademarks have ancient roots, dating back to Roman times. "The principle underlying trademark protection is that distinctive marks—words, names, symbols, and the like—can help distinguish a particular artisan's goods from those of others." *B&B Hardware, Inc. v. Hargis Indus.*, 135 S. Ct. 1293, 1299 (2015). The Lanham Act was based on that principle, and some of the statutory bars to registration help to avoid confusion and deception between marks and the products they identity. But "Section 2(a) is anomaly in this context. It purports to protect the public morals." *Terrifying Trademarks*, 25 Alb. L.J. Sci. & Tech. at 237. The primary purpose of trademark law is to avert confusion in the minds of consumers when purchasing goods. A consumer who attends a concert given by "The Slants," due to promotion of the band using their name, expects to be listening to and watching the actual band associated with the artistic output and reputation associated with the name that induced the purchase of tickets. The registration of trademarks that contain content an examiner would subjectively determine to be offensive, as defined by section 2(a), does not diminish this primary purpose.

Religious themes. Examples of rampant subjectivity include several cases involving marks containing religious connotations. (For a full discussion of these cases, see *Hodgepodge*, 17 Rutgers J. Law &

Relig. at 330-341.) In *In re Riverbank Canning Co.*, 95 F.2d 327 (C.C.P.A. 1938), the court upheld the refusal to register "Madonna" as a mark for the sale of wine, based on the assumption that "Madonna" could only refer to the Virgin Mary.

> All in all, *In re Riverbank Canning* stands for the proposition that assessing a mark under Section 2(a) inherently involves the injection of the reviewer's subjective belief. Here, the court injected its own beliefs about how wine consumption was seen in the general public. Unfortunately, this approach has permeated trademark law.

Hodgepodge, 17 Rutgers J. Law & Relig. at 330. Another case involved a trademark using the phrase "Agnus Dei" (Latin for "Lamb of God") for metallic tabernacle safes used by Roman Catholic churches. The court upheld the rejection of this mark despite evidence that priests and bishops who purchased the safes did not object to the phrase. *In re Summit Brass and Bronze Work, Inc.*, 59 U.S.P.Q. 22, 1943 WL 8300 (TTAB 1943).

In re Lebanese—the case that initiated the "substantial composite" test—upheld the rejection of a trademark application using the term "KHORAN" to identify alcoholic beverages, because the Koran forbids consumption of alcoholic beverages. The court embarked on a theological excursion—ordinarily forbidden judicial territory in any other context:

> [T]he Board's reasoning was a sham. In one sentence the Board notes that they are not in a position to interpose their own judgment with

> that of Muslims, but in the very next sentence, the Board, after considering the tenets of Islam, made an assumption that a "substantial composite" of Muslim Americans would be disparaged by the mark KHORAN on wine. It is clear from the opinion that the only evidence considered was documents summarizing the religious doctrine of Islam, without any input from Muslim Americans themselves. Perhaps, this is true and a "substantial composite" of the population would find the mark disparaging - but that is not the point. Rather, the tragedy of the decision is that no evidence was used actually indicating that disparagement might occur. Rather, the Board relied on *pure conjecture and subjective interpretation* of the fact that Islam bars the consumption of alcohol.

Hodgepodge, 17 Rutgers J. Law & Relig. at 334 (emphasis added).

The mark HEEB, used to develop a lifestyle brand for clothing and entertainment, was rejected because "Heeb" has been used historically as a derogatory term for Jews—even though the *same* mark, for the *same* applicant, was previously approved for publishing magazines. *In re Heeb Media, LLC*, 89 U.S.P.Q.2d 1071, 2008 WL 5065114 (T.T.A.B. 2008)

One of the most recent cases, *In re Geller*, 751 F.3d 1355, held that "STOP THE ISLAMISATION OF AMERICAN" was disparaging and could not be registered. Geller, an activist opposed to the construction of a mosque near Ground Zero in New York City, argued that the phrase had a political rather than religious meaning. The Federal Circuit upheld the

Board's finding that the mark was disparaging to American Muslims under either meaning. Yet political speech and religious speech are both at the heart of the First Amendment.

Unbridled discretion. The subjectivity of the trademark approval process is reminiscent of the concerns about "unbridled discretion" that arise in a speech forum. In cases involving nonpublic or limited public forums, a policy that does not provide sufficient criteria to prevent viewpoint discrimination generally will not survive constitutional scrutiny. *See, e.g., Hague v. Committee for Industrial Organization*, 307 U.S. 496, 516 (1939) (ordinance could be used for arbitrary suppression of free expression because it enabled the Director of Safety to refuse a permit based on his mere opinion that such refusal would prevent "riots, disturbances or disorderly assemblage"); *Lakewood v. Plain Dealer Pub. Co.*, 486 U.S. 750, 758 (1988) (without clear standards, licensing official could use "shifting or illegitimate criteria" to suppress disfavored expression); *Reed v. Town of Gilbert*, 135 S. Ct. 2218, 2229 (2015) (a Sign Code compliance manager who disliked the Church's substantive teachings could potentially deploy the Code to make it more difficult for the Church to inform the public of the location of its services). Such unbridled discretion can intimidate persons into censoring their own speech, and render it difficult to determine whether an official has legitimately denied access or illegitimately abused power. *Lakewood*, 486 U.S. at 757-758.

Comparable concerns are present in the trademark context. As concurring Judge O'Malley observed, the PTO's Assistant Commissioner voiced concerns early in

the process that "the word 'disparage' . . . is going to cause a great deal of difficulty in the Patent Office, because . . . it is always going to be just a matter of the personal opinion of the individual parties as to whether they think it is disparaging." *Hearing on H.R. 4744 Before the Subcomm. on Trademarks of the H. Comm. on Patents*, 76th Cong. 21 (1939) (statement of Leslie Frazer). *In re Tam*, 808 F.3d at 1363 (O'Malley, J., concurring). The trademark examination process reveals an unacceptably high level of discretion. Trademark Manual of Exam. Proc. ("TMEP") § 1203.03 (Jan. 2015 ed.) "does not require an examiner who finds a mark disparaging to consult her supervisor or take any further steps to ensure the provision is applied fairly and consistently across the agency." *In re Tam*, 808 F.3d at 1331. "A *single examiner, with no input from her supervisor*, can reject a mark as disparaging by determining that it would be disparaging to a substantial composite of the referenced group." *Id.* (emphasis added). Such open-ended power could be easily manipulated to advance an examiner's viewpoint or to chill an opposing viewpoint.

Moreover, there is inherent uncertainty in the phrase "may disparage." 15 U.S.C. § 1052(a). Opinions may vary as to whether a particular term disparages a certain group. In *In re Summit Brass and Bronze Work* (discussed above), there was evidence that priests and bishops who purchased safes with the allegedly disparaging "Agnus Dei" mark did not object to the phrase. "[R]egulated parties should *know what is required* of them so they may act accordingly," and particularly where speech is at issue, "precision and guidance are necessary so that those enforcing the law do not act in an arbitrary or discriminatory way."

F.C.C. v. Fox Television Stations, Inc., 132 S. Ct. 2307, 2317-18 (2012).

Every time a mark is rejected as "disparaging," it is because "the government [has] made [a] moral judgment[] based solely and indisputably on the mark['s] expressive content." *In re Tam*, 808 F.3d at 1338. The First Amendment precludes this type of government judgment.

Secondary Meaning. The government never considers the development of "secondary meanings" in trademark law. Trademark law is designed to function of the world of business and commerce. A successful mark will eventually take on a *secondary meaning* separate and apart from its literal meaning. For example, the name of the technology giant, Apple, no longer evokes the thought of fruit in the mind of a consumer but rather it has taken on the *secondary meaning* of smartphones, iPads and laptops. Similarly, Mr. Tam "explicitly selected his mark to create a dialogue on controversial political and social issues." *In re Tam*, 808 F.3d at 1338. He wished to transform a phrase that dealt with racial and ethnic identity and alter its meaning in order to "shift the meaning of, and thereby reclaim, an emotionally charged word." *Id.*

B. Suppression Of Protected Speech In The Form Of Viewpoint Discrimination Is The Inevitable Result Of The Subjective Examination Process.

Section 2(a) is indisputably content-based on its face, because it "draws distinctions based on the message a speaker conveys." *Sorrell v. IMS Health, Inc.*, 131 S. Ct. at 2663; *see also Reed,* 135 S. Ct. at

2227. Even Petitioner admits that "[u]nder Section 1052(a)'s disparagement provision, registrability depends on the content of the mark for which registration is sought. . . ." Pet. Op. Br. 36. Moreover, when the government regulates speech based on "the specific motivating ideology or the opinion or perspective of the speaker," that is viewpoint discrimination, an "egregious form of content discrimination." *Rosenberger v. Rector and Visitors of Univ. of Va.*, 515 U. S. 819, 829 (1995). Here, "the test for disparagement—whether a substantial composite of the referenced group would find the mark disparaging—makes clear that it is the nature of the message conveyed by the speech which is being regulated." *In re Tam*, 808 F.3d at 1335.

The dissent objects that viewpoint discrimination requires *government* disagreement rather than the "assessment of a non-government perspective." *In re Tam*, 808 F.3d at 1372 (Dyk, J., dissenting). Certainly the government may not prohibit or penalize speech because of its own disapproval. *R.A.V. v. City of St. Paul*, 505 U.S. at 382; *Ward v. Rock Against Racism*, 491 U.S. at 791; *Reed*, 135 S. Ct. at 2227. But the prohibition does not end there. "Listeners' reaction to speech is not a content-neutral basis for regulation." *Forsyth Cty. v. Nationalist Movement*, 505 U.S. 123, 134 (1992). "If there is a bedrock principle underlying the First Amendment, it is that the government may not prohibit the expression of an idea simply *because society finds the idea itself offensive or disagreeable*." *Texas v. Johnson*, 491 U.S. 397, 414 (1989) (emphasis added).

Boos v. Barry, 485 U.S. 312 (1988) does not support the constitutionality of the disparagement provision even assuming, arguendo, viewpoint neutrality. The dissent cites this case as an example of a similar statute this Court found viewpoint neutral. *In re Tam*, 808 F.3d at 1371 (Dyk, J., dissenting). The challenged statute prohibited display of any sign within 500 feet of a foreign embassy that would tend to bring that foreign government into "public odium" or "disrepute." The determination was made by reference to the policies of foreign governments. *Boos v. Berry*, 485 U.S. at 319. This Court found the statute viewpoint neutral but nevertheless invalid, explaining that "the government has determined that an entire category of speech—signs or displays critical of foreign governments—is not to be permitted." *Id.* The same is true here. An "entire category of speech"—marks that may be disparaging to specified persons or groups—is proscribed. Moreover, the danger of viewpoint discrimination and censorship is much higher. The phrase "may disparage" is so indefinite, and the approval determination so highly subjective, that the process is easily manipulated to suppress viewpoints the government examiner finds disagreeable.

C. Strict Scrutiny Must Be Applied To This Content-Based Statute.

This Court recently reaffirmed that content-based laws "are presumptively unconstitutional and may be justified only if the government proves that they are narrowly tailored to serve compelling state interests." *Reed*, 135 S. Ct. at 2226. *See also Sorrell*, 131 S. Ct. at 2664 ("The First Amendment requires heightened scrutiny whenever the government creates a regulation

of speech because of disagreement with the message it conveys."). The government refuses to register "disparaging" trademarks because of disagreement with the messages conveyed, and examiners appear to have carte blanche to make the determination.

The government must show a "compelling interest" in rendering such content-based judgments. The dissent suggests that "the purpose of the statute is to protect underrepresented groups in our society from being bombarded with demeaning messages in commercial advertising" (*In re Tam*, 808 F.3d at 1364 (Dyk, J., dissenting)), but the actual language of the Lanham Act describes a much different objective:

> The intent of this Act is to regulate commerce within the control of Congress by making actionable the deceptive and misleading use of marks in such commerce; to protect registered marks used in such commerce from interference by State, or territorial legislation; to protect persons engaged in such commerce against unfair competition; to prevent fraud and deception in such commerce by the use of reproductions, copies, counterfeits, or colorable imitations of registered marks; and to provide rights and remedies stipulated by treaties and conventions respecting trademarks, trade names, and unfair competition entered into between the United States and foreign nations.

15 U.S.C.S. § 1127. Trademark law is based on principles of unfair competition and the tort of consumer deception. *See* Mark McKenna, *The Normative Foundations of Trademark Law*, 82 Notre Dame L. Rev. 1839, 1840-41 (2007); *Hodgepodge*, 17

Rutgers J. Law & Relig. at 318. The statutory language tracks the familiar purposes of registration—to identify the source of goods and services and to protect the markholder's investment. This is not civil rights legislation designed to ensure access to public accommodations. In *R.A.V.*, this Court rejected the City's assertion that an ordinance prohibiting cross burning "helps to ensure the basic human rights of members of groups that have historically been subjected to discrimination." *R.A.V. v. City of St. Paul*, 505 U.S. at 395. Although this interest may be legitimate and even compelling, "the danger of censorship presented by a facially content-based statute requires that the weapon be employed only where it is necessary to serve the asserted [compelling] interest." *Id.* (internal citations and quotation marks omitted).

CONCLUSION

This Court should affirm the Federal Circuit ruling.

Respectfully submitted,

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